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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NGUYEN, MERILYN P

ART UNIT PAPER NUMBER

2161

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/007,696	TESSMAN ET AL.	
	Examiner	Art Unit	
	Merilyn P. Nguyen	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Detailed Action</u> . |

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DETAILED ACTION

1. In response to the communication dated 1/24/2005, claims 1-60 are pending in this office action as the results of the addition of claim 60.

2. This application claims benefit of US provisional application 60/251,834 filed on December 8, 2000.

Acknowledges

3. Receipt is acknowledged of the following items from the Applicant:
- o The applicant amendment has been considered and made of record as Paper No. dated January 24, 2005.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 22 and 60 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 22 and 60 recites a method claim and lacks the specific use of technology in the claimed features of the claim. Claim 22 presents only a trivial recitation of technology that is not sufficient to encompass the use of technology in execution of the claimed feature. All of the features currently specified in the independent claim 22 may be

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accomplished without the use of technology, e.g., monitoring digital images (monitoring digital prints).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, line 10, claim 15, line 9, claim 16, line 10, claim 21, line 5, the phrase "such that" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 22, the term "complaint" is used by the claim and by the applicant to mean "the basis for regulating access to the digital...such as launch an investigation, control purging operations on purging server 2418, or regulate other users' access to the digital image" as pointed by Applicant at page 14 paragraph 4 of the Remarks dated 1/24/2005, while the accepted meanings are:

"1 expression of grief, pain, or dissatisfaction

2 a: something that is the cause or subject of protest or outcry

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b: a bodily ailment or disease

3: a formal allegation against a party.”¹

The term is indefinite because the specification does not clearly redefine the term. The examiner points out that the only place the applicant discloses the term “complaints” is at page 10, line 6 of the specification with no redefinition. Thus, in the interest of compact prosecution, this term has no patentable weight. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999).

Regarding claims 4, 25, 38 and 50, there is insufficient antecedent basis for “translating the storage path information”. It’s unclear what the storage path information is translated to.

Regarding claim 60, there is insufficient antecedent basis for “online identity”. It’s unclear what the applicant meant by “online identity”.

Claims 2-14, 17-20, and 23-59 are rejected for being dependent from rejected base claims.

Claim Rejections - 35 USC § 102

¹ Please note that the definition of “complaint” is defined by Meriam-Webster Online Dictionary, <http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=complaint>

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 22 and 60 are rejected under 35 U.S.C. 102(e) as being anticipated by Stewart (US 6,389,460).

Regarding claim 22, Stewart discloses a method of monitoring digital images comprising: receiving a complaint associated with a digital image from a first subscriber; and regulating access of the first subscriber to the digital image (See col. 8, lines 45-65, and col. 13, lines 13-26). As noted above in the 35 U.S.C 112 section, the term “complaint” is indefinite because the specification does not clearly redefine the term, therefore the examiner considers “a complaint” is “a user request”.

Regarding claim 60, Stewart discloses regulating access of an online identity other than the first subscriber to the digital image based on the complaint (See col. 8, lines 57-65, wherein regulating access is established through the user of proxies).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 21 and 49-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart (US 6,389,460), in view of Sasich (US 6,661,904).

Regarding claim 21, Stewart discloses a method of identifying a storage path used to store digital images within a computer system (See col. 15, line 64 through col. 17, line 67) comprising: generating at least one image identifier (See col. 16, lines 33-40) associated with a first storage facility (214, Fig. 2), a directory (Fig. 8) within the first storage facility (See col. 10, lines 55-67, and more detail in col. 20, lines 12-25), and identifying a storage path using the at least one image identifier (See col. 17, lines 8-45). As the Examiner rejected above in the 35 U.S.C 112 section, the phrase "such that" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention, thus the examiner treats it as no patentable weight.

Stewart is silent as to generating at least one image identifier associated with a random number. On the other hand, Sasich teaches generating image identifier associated with a random number (See col. 8, lines 1-10, Sasich et al.). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to generating image identifier associated with a random as suggested by Sasich. The motivation would have been to make image unique.

Regarding claim 49, Stewart/Sasich discloses wherein identifying a storage path comprises extracting storage path information from at least one image identifier (See col. 17, lines 8-12, Stewart et al.).

Regarding claim 50, Stewart/Sasich discloses translating the storage path information (See col. 17, lines 12-13, Stewart et al.).

Regarding claim 51, Stewart/Sasich discloses wherein identifying a storage path comprises using the unique hash value as a filename (See col. 11, lines 32-39, and col. 26, lines 4-11, Stewart et al.).

Regarding claim 52, Stewart/Sasich discloses storing the digital image in the first storage facility at the identified storage path (See col. 5, lines 1-4, and col. 20, lines 12-49, Stewart et al.).

Regarding claim 53 Stewart/Sasich discloses generating and storing lower resolution thumbnails (compress form) at the identified storage path (See col. 7, lines 15-22, and col. 15, lines 29-35, Stewart et al.).

Regarding claim 54, Stewart/Sasich discloses identifying a second storage facility for storing metadata describing the digital image (See col. 12, lines 9-44, Stewart et al.).

Regarding claim 55, Stewart/Sasich discloses identifying a second storage facility comprises encoding account information associated with the digital image (See col. 4, lines 62-65, and col. 12, lines 9-18, Stewart et al.).

Regarding claim 56, Stewart/Sasich discloses wherein the account information comprises a screen name associated with a subscriber (See col. 4, lines 62-65, wherein cookies and authorizations information correspond to account information, Stewart et al.).

Regarding claim 57, Stewart/Sasich discloses mapping the encoded account information to an appropriate storage space group containing second storage facility (See col. 24, lines 10-14, and col. 25, lines 29-65, Stewart et al.).

Regarding claim 58, Stewart/Sasich discloses storing metadata describing the digital image in the second storage facility (See col. 12, lines 9-44, Stewart et al.).

Regarding claim 59, Stewart/Sasich discloses providing access to the stored digital image and the stored metadata (See col. 18, line 40 to col. 19, line 40, Stewart et al.).

8. Claims 21, 49-50 and 52-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle (US 6,017,157), in view of Sasich (US 6,661,904).

Regarding claim 21, Garfinkle discloses a method of identifying a storage path used to store digital images within a computer system (See col. 3, line 62 to col. 4, line 33) comprising: generating at least one image identifier associated with a first storage facility (See col. 4, lines 7-10), a directory within the first storage facility (See col. 4, lines 25-33), and identifying a storage path using the at least one image identifier such that related digital images have unrelated storage

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paths (See col. 7, lines 25-65, especially lines 34-42). As the Examiner rejected above in the 35 U.S.C 112 section, the phrase "such that" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention, thus the examiner treats it as no patentable weight.

Garfinkle is silent as to generating at least one image identifier associated with a random number. On the other hand, Sasich teaches generating image identifier associated with a random number (See col. 8, lines 1-10, Sasich et al.). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to generating image identifier associated with a random as suggested by Sasich. The motivation would have been to make image unique.

Regarding claim 49, Garfinkle/Sasich discloses wherein identifying a storage path comprises extracting storage path information from at least one image identifier (See col. 4, lines 7-10, Garfinkle et al.)

Regarding claim 50, Garfinkle/Sasich discloses translating the extracted storage path information (See col. 4, lines 7-10, Garfinkle et al.)

Regarding claim 52, Garfinkle/Sasich discloses storing the digital image in the first storage facility at the identified storage path (See col. 4, lines 25-27, Garfinkle et al.)

Regarding claim 53 Garfinkle/Sasich discloses generating and storing lower resolution thumbnails at the identified storage path (See col. 6, line 56 to col. 7, line 3 Garfinkle et al.).

Regarding claim 54, Garfinkle/Sasich discloses identifying a second storage facility for storing metadata describing the digital image (See col. 6, lines 50-55, Garfinkle et al.).

Regarding claim 55, Garfinkle/Sasich discloses identifying a second storage facility comprises encoding account information associated with the digital image (See col. 9, lines 45-64, Garfinkle et al.).

Regarding claim 56, Garfinkle/Sasich discloses wherein the account information comprises a screen name associated with a subscriber (See col. 9, lines 45-64, Garfinkle et al.).

Regarding claim 57, Garfinkle/Sasich discloses mapping the encoded account information to an appropriate storage space group containing second storage facility (See col. 8, lines 49-55, Garfinkle et al.).

Regarding claim 58, Garfinkle/Sasich discloses storing metadata describing the digital image in the second storage facility (See col. 6, lines 50-55, Garfinkle et al.).

Regarding claim 59, Stewart/Sasich discloses providing access to the stored digital image and the stored metadata (See col. 7, lines 61-67, Garfinkle et al.).

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9. Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle (US 6,017,157), in view of Sasich (US 6,661,904), and further in view of Stewart (US 6,389,460).

Regarding claim 51, Garfinkle/Sasich discloses all the claimed subject matter as set forth above, however, Garfinkle/Sasich is silent as to identifying a storage path comprises using the unique hash value as a filename. On the other hand, Stewart teaches identifying a storage path comprises using the unique hash value as a filename (See col. 16, lines 49-57, Stewart et al.). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to using the unique hash value as a filename to identify a storage path as suggested by Stewart. The motivation would have been to providing rapid access to data items which are distinguished by some key.

Response to Arguments

10. Applicant's arguments filed on 01/24/2005 with respect to the rejections of claims 1-59 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

Applicant argues that ““a user request” for content is different from “a complaint.” Stewart's user request relates to the normal operation of an image retrieval system. In contrast, as recited by independent claim 22, Applicant's “a complaint” serves as the basis for regulating access to the digital image. For example, the complaint may be used to launch an investigation (step 610), control purging operations on purging server 2418, or regulate other users' access to the digital image. Since Stewart's “user request” is different from Applicant's “complaint” Stewart does not teach a complaint associated with a digital image from a first subscriber.” The

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examiners respectfully points out that as noted above in the 35 U.S.C 112 section, the term “complaint” is indefinite because the specification does not clearly redefine the term, therefore the examiner considers “a complaint” is “a user request”.

Applicant argues that Steward does not teach related digital images have unrelated storage paths. The examiner respectfully points out that as the Examiner rejected above in the 35 U.S.C 112 section, the phrase "such that" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention, thus the examiner treats it as no patentable weight.

Allowable Subject Matter

11. Claims 1-20 and 23-48 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 1, 15, and 16, the prior art of record (Stewart et al., U.S Patent No. 6,389,460) fails to disclose or suggest the claimed steps of identifying the storage path using the first and second image identifiers and the unique hash value in the conjunction with the remaining, salient claim provisions.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Blumenau U.S Patent No. 6,845,395 discloses method and apparatus for identifying network devices on a storage network.

Hinoue U.S Patent No. 6,118,485 discloses card type camera with image processing function.

Roberts U.S Patent No. 6,323,899 discloses process for use in electronic camera.

Kahn U.S Patent No. 6,135,646 discloses system for uniquely and persistently identifying, managing, and tracking digital objects.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Merilyn P Nguyen whose telephone number is 571-272-4026.

The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MN

MN

April 29, 2005


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
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